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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/087,167	10/24/2001	Erica J. Pascal	50018A	4256

22847 7590 10/06/2003

SYNGENTA BIOTECHNOLOGY, INC.

PATENT DEPARTMENT

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EXAMINER

MARVICH, MARIA

ART UNIT

PAPER NUMBER

1636

9

DATE MAILED: 10/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/087,167

Applicant(s)

PASCAL ET AL.

Examiner

Maria B Marvich, PhD

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-97 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-97 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not). Claims 33-35 are missing from the claims as filed. Accordingly, misnumbered claims 36-84 been renumbered 32-80.

It is noted that in a preliminary amendment filed 10/28/01, Paper No. 7, applicants requested that claims 15-17, 30-37, 46-69 and 78-101 be cancelled. This amendment was not entered to avoid cancellation of incorrect claims due to misnumbered claims 36-101.

Claims 1-97 are pending in this application and subject to the following restriction requirement:

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-39, 42-43, 50-51, 58-59, 66-67, 74-75, 82-83 and 90-91 drawn to a receptor cassette encoding a chimeric receptor polypeptide comprising a DNA binding domain (C), a hinge domain (D), a ligand binding domain (E) and an activation domain, classified in class 435, subclass 69.1.
- II. Claims 40, 48, 56, 64, 72, 80, 88 and 96 drawn to a method of controlling gene expression in a plant using a receptor expression cassette to express chimeric receptor polypeptides to direct expression from a response element corresponding

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to the DNA binding domain of the receptor operatively linked to a target nucleic acid, classified in class 435, subclass 410.

III. Claims 41, 49, 57, 65, 73, 81, 89 and 97 drawn to a chimeric receptor polypeptide encoded by Group I, classified in class 530, subclass 351.

IV. Claims 36-39, 44-47, 52-55, 60-63, 68-71, 76-79, 84-87 and 92-95 drawn to transgenic host cells, plants and seeds, classified in class 800 subclass 278.

The inventions are distinct each from the other because of the following reasons:

The receptor cassette of Group I and the methods of Group II are related as product and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP 806.05 (h)). In the instant case, the receptor cassettes of Group I can be used in materially different methods from those of Group II, (e.g. they can be used to detect related receptors in hybridization assays).

The receptor polypeptides of Group III and the methods of Group II are related as product and processes of use. In the instant case, the receptor polypeptides of Group III can be used in materially different methods from those of Group II. The polypeptides of Group III can be used to produce antibodies.

The receptor cassette of Group I, the polypeptide of Group III and the transgenic plants, cells and seed of Group IV are directed to products that are distinct both physically and functionally from one another and therefore have different modes of operation, different

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functions and different effects. Therefore, the inventions of the different groups are capable of supporting separate patents.

The transgenic plants, cells and seeds of Group IV and the methods of Group II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions the methods of Group II are used to control gene expression in a plant using a receptor expression cassette that encodes chimeric receptor polypeptides. The transgenic plants are not utilized in the methods of Group II and have uses independent of the method of Group II.

This application contains claims directed to the following patentably distinct species of the claimed invention: species of DNA binding domains, species of hinge domains, species of ligand binding domains. Thus, applicants are required to select a single DNA binding domain from the species, a single hinge domain from the species and a single ligand-binding domain from the species.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 3, 21-25, 34-40 and 66-70 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

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Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

The searches required for the different groups are not coextensive. These inventions are distinct or the reasons given above and have acquired a separate status in the art Group I (435/69.1) versus Group II (435/410) versus Group III (530/351) as shown by their different classification and their recognized divergent subject matter.

Applicant is reminded that upon cancellation of claims to a non-elected inventions, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

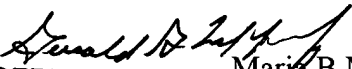
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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maria B Marvich, PhD whose telephone number is (703) 605-1207. The examiner can normally be reached on M-F (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel, PhD can be reached on (703) 305-1998. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3291.

  
**GERRY LEFFERS** Maria B Marvich, PhD  
**PRIMARY EXAMINER** Examiner  
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